



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,326	12/29/2000	Pankaj Kedia	42390P10227	1211

7590 11/20/2003

Stephen T. Neal
Blakely, Sokoloff, Taylor & Zafman LLP
Seventh Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025-1030

EXAMINER

CHEN, TSE W

ART UNIT	PAPER NUMBER
----------	--------------

2185

DATE MAILED: 11/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/753,326

Applicant(s)

KEDIA ET AL.

Examiner

Tse Chen

Art Unit

2185

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of copending Application No. 09752644. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims do not provide any processing means with a speech recognition unit in the claimed low-power subsystem. Ergo, the neglect of this processing means difference renders the present claims to be broader than the co-pending Application claims, and would necessarily conflict with the co-pending Application claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2185

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 7, 9, and 10-12 are rejected under 35 U.S.C. 102(e) as being anticipated by

Barber et. al., U.S. Patent 6240521, hereinafter referred to as Barber.

5. As per claims 1 and 2, Barber taught an invention comprising:

- a central processing unit [FIG. 1, item 12];
- a memory device coupled to the central processing unit [FIG. 1, item 20]; and
- a low-power subsystem [FIG.1, item14] having a database accessible by a processor and synchronized with the memory device [column 3, line 4; column 3, lines 43-45], the low-power subsystem in operation when the central processing unit enters a low power mode [FIG. 4; column 4, lines 14-18].

6. As per claim 3, Barber taught the data contained within the database includes multimedia data [column 1, line 65 to column 2, line 1]. Barber's proposal of using the high-speed processor for multimedia presentations implicitly means that multimedia data can exist in the memory space shared by both systems.

7. As per claims 7 and 9, Barber taught the displaying of the data accessed by suggesting the use of the low-power processor for word-processing purpose [column 2, lines 13-14].

8. As per claims 10 and 12, Barber taught the claimed method. Therefore, Barber taught the system through which the method is implemented.

Art Unit: 2185

9. As per claim 11, Barber taught a housing unit containing the central processing unit and the low-power subsystem by advocating the advantage of having two different processors within a single notebook computer [column 2, lines 20-26].

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 4-5, 8, 13-15, 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barber in view of Ditzik, U.S. Patent 5983073.

12. Barber disclosed a system and method comprising of aforementioned aspects listed in previous section. However, Barber did not expressly disclose any particular interface or method for communication or data access.

13. Ditzik disclosed a computer system, and thus the method of operating said system, with an advocated advantage of being operational in a closed configuration [column 9, lines 55-59] wherein the following attributes are expressed.

14. As per claim 4, Ditzik taught the data can be accessed from a network [FIG. 7, item 33; column 6, lines 22-27].

15. As per claims 5 and 13, Ditzik taught the network can be accessed using a wireless interface [FIG. 7, item 32; column 4, lines 53-57].

16. As per claim 8, Ditzik taught the data can be presented via an audio medium [FIG. 7, items 10A-B; column 12, lines 43-44; FIG. 2, item 30; column 6, lines 49-51].

Art Unit: 2185

17. As per claims 14 and 15, Ditzik taught the wireless network interface can be connected with a local area network or a wide area network [column 12, lines 58-64].

18. As per claim 17, Ditzik taught the user interface can be wireless [FIG. 7, items 51, 14, and 34].

19. As per claim 18, Ditzik taught an audio headset can be used to receive audio data transmitted from the wireless user interface [FIG. 7, item 34; column 8, lines 35-42].

20. As per claim 19, Ditzik taught a cellular phone can be used to receive data transmitted from the wireless user interface [FIG. 7, item 14; column 5, lines 52-59].

21. An ordinary artisan in the art at the same time the invention was made would have been motivated to look for a way to add communication and networking functions as taught by Ditzik to a low-power computer system as disclosed by Barber to further extend the system's capabilities.

22. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Barber's teachings with the teachings of Ditzik to provide a wireless networked/interfaced computer system that can conserve power by operating in a low-power mode.

23. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barber and Ditzik as applied to claims 4-5, 8, 13-15, and 17-19 above, and further in view of Chen et. al., U.S. Patent 5590197, hereinafter referred to as Chen.

24. Barber and Ditzik combined disclosed a method of providing wireless network/communication capability to the user of a computer system in low-power mode.

Art Unit: 2185

However, neither expressly disclosed the network as an electronic store allowing electronic purchase.

25. Chen disclosed a network with multitudes of electronic store merchants setup for secured electronic commerce [FIG. 1; column 4, lines 46-50].

26. An ordinary artisan in the art at the same time the invention was made would have been motivated to look for a way to access the growing number of electronic stores via the network enabled computer system as disclosed by Barber and Ditzik to take advantage of the product variety and convenience of shopping.

27. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the teachings of Barber, Ditzik and Chen to take advantage of the burgeoning electronic commerce via an energy-conserving computer system.

28. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barber in view of Hollon, U.S. Patent 5768164.

29. Barber disclosed a system and method comprising of aforementioned aspects listed in previous section. However, Barber did not expressly disclose an additional display.

30. Hollon disclosed a computer system with an additional display that can still display data even with the computer cover closed [column 3, lines 2-5]. The display can be an LCD [column 2, lines 54-55)], which can be configured to output video by one skilled in the art.

31. An ordinary artisan in the art at the same time the invention was made would have been motivated to look for a way to add an additional display to quickly and expeditiously output

Art Unit: 2185

stored data with the computer system as disclosed by Barber and Miyazawa when the cover is closed during transport.

32. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Barber's teachings with the teachings of Hollon to provide an additional display that can still output data when the cover is closed and the system is in low-power mode.

33. Claims 20-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barber, Chen and Ditzik as applied to claims 1-9 above, and further in view of Fukuda et. al., U.S. Patent 4497021, hereinafter referred to as Fukuda.

34. Barber, Chen and Ditzik combined disclosed a system and method comprising of aforementioned aspects related to claimed invention as listed in previous section with the transition to power mode determinable by software [see Barber column 2, lines 8-11]. However, Barber did not expressly disclose the origin of the software instructions, which may or may not be from a machine-readable storage medium such as a magnetic disk.

35. Fukuda disclosed a computer system that can select the operating mode from a sequence of instructions stored on a machine-readable storage medium [column 1, lines 41-45; column 3, lines 12-17].

36. An ordinary artisan in the art at the same time the invention was made would have been motivated to look for a way to transition to a low-power mode via an external machine-readable storage medium with the computer system as disclosed by Barber, Chen and Ditzik combined in order to convenient the user by making the instruction sequence transferable from remote sites.

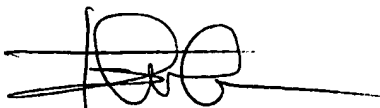
Art Unit: 2185

37. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the teachings of Barber, Chen, Ditzik and Fukuda to provide the capability to transition to a different power mode via a machine-readable storage medium so the user can have more control and also the option of doing a transition remotely.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tse Chen whose telephone number is (703) 305-8580. The examiner can normally be reached on Monday - Friday 9AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Lee can be reached on (703) 305-9717. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Tse Chen
November 3, 2003



THOMAS LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100